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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,931	06/30/2000	Jay S. Walker	99-099	2766

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT PAPER NUMBER

3627

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/609,931

Applicant(s)

WALKER ET AL.

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24,27-30,33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24,27-30,33 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24, 27-30, 33 and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,567,787. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The claims of Walker et al (hereafter '787) show receiving customer information at a processing device including transaction information (e.g., receiving information related to items purchased by the customer during the transaction); identifying a query based at least in part on customer data (e.g., cl. 15); outputting and indication of the query; prompting an attendant to present the query; and receiving a verbal response to the query.

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As to claims 2, 5, 7, 8, 10-12, 14, 19, 20, 22, 23, and 28, it is noted that '787 shows all elements of the claims.

As to claims 3 and 4, the claims of '787 show all except that the response to the additional query (e.g., survey questions) is verbal. However, it is notoriously old and well known in the art to receive verbal responses to survey questions. It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '787 by receiving verbal responses in order to provide an intuitive and natural customer interface.

As to claim 7, the claims of '787 inherently show that the transaction information includes information identifying a beginning of a transaction, since in order such information must exist (at least in terms of the first item scanned) in the step of initiating a transaction.

As to claim 21, the claims of '787 recite a POS terminal. As broadly claimed such devices are portable or capable of being moved about (portable is defined as "capable of being carried or moved about" by *Meriam Webster's Collegiate Dictionary*, 10th ed.).

Claims 8, 9, 15-18, 24, 27-30, 33 and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,567,787 in view of Walker et al (6,119,099).

As to claim 8, the claims of '787 show all elements except transaction information that a transaction is complete. '077 show receiving customer information from previous transactions which inherently identify those transactions as complete. It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '787 by providing the information as taught by '077 in order to provide information from previous complete transactions on which to base queries.

As to claim 9, the claims of '787 show all elements except that the query is based at least in part on transaction information from a previous transaction. '077 shows determining a query based at least partly on previous transaction data. It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '787 as taught by '077 in order to provide more effective offers.

As to claim 15, the claims of '787 show all elements except generating output data based on the verbal response to the query and categorizing the data. '077 shows generating and categorizing output data comprising a positive or negative response to an upsell. It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '787 as taught by '077 in order to provide a system for upselling and determining whether to offer a second upsell based on the categorized response to the first.

As to claims 16-18, 27 and 29, it is noted that the claims of '787 in view of '707 show all elements.

As to claim 24, the claims of '787 show all elements except determining an offer based on a verbal response and presenting the offer. '077 shows this element. It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '787 as taught by '077 in order to enable an effective upselling process.

As to claim 30, the claims of '787 show all elements of the claim except categorizing a customer response. '077 shows this step (e.g., categorizing a response as positive or negative). It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '787 as taught by '077 in order to provide a basis for taking further action (such as providing additional queries in response to the categorized answer).

As to claim 35, the claims of '787 show all elements except analyzing a response to determine if a remediation is required and instructing and attendant to present the remediation response. '077 shows these steps. It would have been obvious to one of ordinary skill in the art to modify the method of the steps of '787 as taught by '077 in order to allow a second upsell to be made.

Claim 33 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,567,787 in view of Dejaeger et al (6,456,981)

The claims of '787 show all elements except that the survey question is identified based at least in part on the customer information and that the attendant is prompted to

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verbally present the question. Dejaeger shows identifying at least a survey question based at least in part on the customer data. It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '787 by providing a question selected based on the customer data in order to better focus the question. Regarding prompting the attendant to verbally present the question, it is notoriously old and well known in the art to present a survey question verbally. It would have been obvious to one of ordinary skill in the art to further modify the method of the claims of '787 by doing so in order to provide a natural and intuitive interface for the customer.

Claim 35 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,567,787 in view of "re: Overcharging..."

The claims of '787 show all elements of the claim except analyzing a response to determine if a remediation is required and instructing and attendant to present the remediation response. "Re: Overcharging..." shows analyzing a response to determine a remediation response comprising selling the items for the clearance price, and instructing the attendant to present the remediation response comprising carrying out the transaction at the reduced price. It would have been obvious to one of ordinary skill in the art to further modify the method of Dejaeger by doing so in order to increase customer satisfaction.

Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,567,787 in view of the www.atpos.com webpages.

The method of the claims of '787 show all elements except receiving customer information via a portable computing device. www.atpos.com show such a device. It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '787 by providing such a device in order to read data from smart cards and so on and in order to provide portability so that the POS can be set up where needed.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

STEVE B. MCALLISTER
PRIMARY EXAMINER